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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,390	07/23/2003	Vladimir A. Stoy	1135-21RE	9069

7590 11/08/2006  
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EXAMINER

STEWART, ALVIN J

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/625,390

Applicant(s)

STOY, VLADIMIR A.

Examiner

Alvin J. Stewart

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-38 is/are allowed.
- 6) ☒ Claim(s) 39, 40 and 43-47 is/are rejected.
- 7) ☒ Claim(s) 41, 42, 48 and 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

***Reissue Applications***

The litigation regarding Application serial number 10/625,390 has been resolved as shown by the Applicant's representative in the document filed on 08/09/06.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39, 40, 43, 45 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Bao et al US Patent 5,534,028.

Bao et al discloses a spinal disc implant comprising a swellable plastic, whereby upon at least partial hydration of the implant member, the implant member undergoes anisotropic expansion and has a capacity to swell to a length along the longitudinal axis which is greater than the space between the adjacent vertebrae (see col. 5, lines 17-45).

Regarding claim 43, see col. 7, lines 1-6.

Claims 39, 40, and 43-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Ray et al US Patent 5,674,295.

Ray et al discloses a spinal disc implant comprising a swellable plastic, whereby upon at least partial hydration of the implant member, the implant member undergoes anisotropic expansion and has a capacity to swell to a length along the longitudinal axis which is greater than the space between the adjacent vertebrae (see Fig. 9; col. 4, lines 27-44).

Regarding claim 44, see col. 4, lines 45-54.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bao et al US Patent 5,534,028.

Bao et al discloses the invention substantially as claimed. However, Bao et al does not disclose a xerogel implant.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the hydrogel material of the Bao et al reference with xerogel material because Applicant has not disclosed that by having a xerogel material provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with hydrogel material of the Bao et al reference because it would perform equally as well.

Therefore, it would have been an obvious matter of design choice to modify Bao et al reference to obtain the invention as specified in claim 39.

***Response to Arguments***

Applicant's arguments filed 08/09/06 have been fully considered but they are not persuasive.

The Applicant's representative argues that the prior art do not disclose a spinal implant that undergoes anisotropic expansion and do not disclose a second height which is greater than the height of a cavity defined between adjacent vertebrae.

However, the Examiner believes that the prior art discloses all the structure limitations entered in the claims. For example, the Bao et al reference discloses an intervertebral implant comprising a hydrogel material capable of having a constant swell when fluid is absorb by the implant. The hydrogel implant is capable of having a water contents from about 30% to 90% making the implant constrained tightly in the cavity of the disc (see col. 5, lines 23-35). For the above reasons, the Examiner believes that by having an implant constrained tightly in the cavity of the disc, the implant, per se, is capable of expanding beyond the height of the disc cavity. If that was not the case, the implant would not be able to be inserted tightly in the cavity of the disc.

Regarding the anisotropic movement of the implant, the Examiner believes that the prior art also reads on the rejected claims because as shown in Figure 14, the implant is made out of two different materials, therefore, the material will have an anisotropic movement (see col. 7, lines 1-6).

***Allowable Subject Matter***

Claims 1-37 are allowed.

Claims 41, 42, 48 and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**ALVIN J. STEWART**  
**PRIMARY EXAMINER**  
Art Unit 3738

November 02, 2006.